UNITED STATES PATENT AND TRADEMARK OFFICE

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10/677,619	10/02/2003	Craig Ogg	61135/P019US/10303184	8929

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CRAIG OGG

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Appeal 2010-009701
Application 10/677,619
Technology Center 3600

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Before: MURRIEL E. CRAWFORD, MEREDITH C. PETRAVICK, and
MICHAEL W. KIM, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-7, 9-12, 14-20, and 22. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002). Oral hearings were held on November 15, 2011.

The claimed invention is directed to high-speed mail processing systems and, more particularly, to a high-speed mail handling system that applies postage or Information-Based Indicia (IBI) to each mail piece on a piece-by-piece basis (Spec., para. [0002]). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A high-speed mail processing system having a conveyor system for transferring a plurality of mail pieces among two or more mail processing components and a controller for directing the operations of the components, the system comprising:
>
> a postage computing device for separately calculating postage value due for each individual mail piece of said plurality of mail pieces, said postage computing device operable to use said calculated postage value to generate an information based postage indicia for a mail piece of said plurality of mail pieces in parallel with the mail piece of said plurality of mail pieces being physically created and processed by at least one mail processing component of said two or more mail processing components;
>
> a postage application printer positioned to print said information based postage indicia on the mail piece of said plurality of mail pieces that is being moved by the conveyor system, wherein said information based postage indicia is available for printing by said postage application printer at the time the mail piece of said plurality of mail pieces arrives at said postage application printer; and
>
> a computer processing system for storing information related to the processing of each individual mail piece of said plurality of mail pieces and for providing the controller with the processing information.

The Examiner relies upon the following prior art:

Freeman	US 4,742,878	May 10, 1988
Manduley	US 5,079,714	Jan. 7, 1992
Huggett	US 5,468,945	Nov. 21, 1995
Chang	US 5,612,888	Mar. 18, 1997
Freeman	US 6,041,569	Mar. 28, 2000[1]
Ryan	US 6,173,274 B1	Jan. 9, 2001
Leon	US 2001/0042052 A1	Nov. 15, 2001
Rasmussen	US 2004/0088267 A1	May 6, 2004

Claims 1-7, 9-12, 14-18, and 22 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; claim 1 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Freeman in view of Leon; claims 2 and 5-6 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Freeman in view of Leon and Chang; claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Freeman in view of Leon and Freeman 2; claims 3, 4, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Freeman in view of Leon and Ryan; claims 11, 12, 15, 16, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan in view of Freeman and Leon; claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan in view of Freeman, Leon, and Manduley; claim 17 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan in view of Freeman, Leon, and Chang; claims 19 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan in view of Freeman, Leon, and Rasmussen; and claim 20 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan in view of Freeman, Leon, Rasmussen, and Official Notice supported by Huggett.

We REVERSE.

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[1] The Examiner refers to this reference as "Freeman 2" (Exam'r's Ans. 9).

ISSUES

Did the Examiner err in asserting that independent claim 1 is
indefinite[2]? The issue turns on whether various recitations of "mail piece"
in the claims all refer to the same object.

Did the Examiner err in asserting that a combination of Freeman and
Leon render obvious independent claim 1[3]? The issue turns on whether the
cited combination renders obvious

> said postage computing device operable to use said calculated
> postage value to generate an information based postage indicia
> for a mail piece of said plurality of mail pieces in parallel with
> the mail piece of said plurality of mail pieces being physically
> created and processed by at least one mail processing
> component of said two or more mail processing components[,]

as recited in independent claim 1.

ANALYSIS

Indefiniteness Rejection

We are persuaded the Examiner erred in asserting that independent
claim 1 is indefinite (App. Br. 7-10; Reply Br. 4-5). The Examiner asserts
that independent claim 1 recites three mailpieces:

• Mailpiece 1: The individual mail piece of the postage computing device.

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[2] In setting forth our analysis, we choose independent claim 1 as
representative, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).
[3] In setting forth our analysis, we choose independent claim 1 as
representative, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

- Mailpiece 2: A mail piece that will contain generated information based indicia.

- Mailpiece 3: The individual mail piece which is being physically created and processed by at least one mail processing component.

(Exam'r's Ans. 5-6, 16-18). However, independent claim 1 recites, at most, two mail pieces. First of all, the various recitations of "the mail piece of said plurality of mail pieces" clearly refers back to "a mail piece of said plurality of mail pieces" recited after "said postage computing device operable to use said calculated postage value to generate an information based postage indicia for" in the first paragraph following the preamble of independent claim 1. Accordingly, at least Mailpieces 2 and 3 referenced by the Examiner are indeed the same mail piece.

Independent claim 1 does not recite "the individual mail piece" as asserted by the Examiner (App. Br. 17-18). Independent claim 1 does additionally recite "each individual mail piece of said plurality of mail pieces." However, claim context shows that the reference to "each individual mail piece" is merely to generally recite that the postage computing device and the computer processing system process and store data for all mail pieces separately: they are not meant to serve as an antecedent basis for other recitations of "mail piece." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (internal citations omitted) ("[q]uite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. To begin with, the context in which a term is used in the asserted claim can be highly instructive"); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) ("the context of the surrounding

words of the claim also must be considered in determining the ordinary and customary meaning of those terms"). Thus, it is immaterial whether or not "each individual mail piece" (Mailpiece 1) coincides with "a mail piece" (Mailpieces 2 and 3). Accordingly, we will not sustain this rejection.

Obviousness Rejection

We are persuaded the Examiner erred in asserting that a combination of Freeman and Leon renders obvious independent claim 1 (App. Br. 10-17). The Examiner has construed the claims to be "able to generate indicia while concurrently processing ***another*** mail piece" (Exam'r's Ans. 18; emphasis added). However, as set forth above, because Mailpieces 2 and 3 are the same, independent claim 1 recites that the system must be capable of generating postage indicia for ***a mail piece*** and physically create ***that same mail piece*** in parallel. As the Examiner used an erroneous construction of independent claim 1 in setting forth the obviousness rejection that excluded the parallel aspect of independent claim 1, we cannot sustain this rejection.

DECISION

The rejections of claims 1-7, 9-12, 14-20, and 22 are REVERSED.

REVERSED

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